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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/565,368

06/21/2006

David Neil Slatter

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EXAMINER

SAVUSDIPHOL, PAULTEP

ART UNIT

PAPER NUMBER

2876

MAIL DATE

DELIVERY MODE

11/19/2007

PAPER

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

## Office Action Summary

Application No.

10/565,368

Applicant(s)

SLATTER, DAVID NEIL

Examiner

Paultep Savusdiphol

Art Unit

2876

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 23 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-20 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-20 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 23 January 2006 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some \* c) ☐ None of:
- 1) ☒ Certified copies of the priority documents have been received.
  - 2) ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3) ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>01/23/2006</u> . | 6) <input type="checkbox"/> Other: _____  |

### **DETAILED ACTION**

Receipt is acknowledged of the amendment, filed on 01/23/06, which has been entered in the file. Application 10/565,368 is a national stage of PCT/GB2004/003171 filed July 22, 2004 which claims the benefit of Great Britain Application No. 0317311.9 filed July 24, 2003.

Claims 1-20 are pending.

### ***Specification***

The disclosure is objected to because of the following informalities: Minor grammatical errors have been noted in the title of the Abstract: "Print Medua wuth" should be corrected to read "Print Media with".

Appropriate correction is required.

### ***Claim Rejections - 35 USC § 103***

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

1. **Claims 1-20** are rejected under 35 U.S.C. 103(a) as being unpatentable over **Spurr et al. (US 6,381,418 B1)** in view of **Patton (US 5,845,160)**.

Regarding **claim 1**, **Spurr** discloses a print having a substrate and a plurality of memory tags coupled to the substrate (Col. 6, lines 40-48 & Col. 9, lines 18-22 -

*wherein the tags are "coupled" to the substrate and more than one may be used), wherein each memory tag comprises a passive electronic memory (Col. 4, lines 64-66 & Col. 5, lines 34-36) and a memory tag is associated with at least some of the images for storage of data relating to the respective images (Col. 3, lines 53-54).*

Regarding **claim 3**, **Spurr** discloses a print according to claim 1 wherein for each image in respect of which data is stored on an associated memory tag, the data relating to the image includes information about the initial creation of the image (Col. 1, lines 27-39).

Regarding **claim 4**, **Spurr** discloses a print according to claim 1 wherein for each image in respect of which data is stored on an associated memory tag, the data relating to the image includes information about the content of the image (Col. 1, lines 27-39).

Regarding **claim 5**, **Spurr** discloses a print according to claim 1 wherein for each image in respect of which data is stored on an associated memory tag, the memory tag associated with the image is located on the substrate adjacent to the respective image (Col. 4, lines 62-67 & Fig. 1).

Regarding **claim 6**, **Spurr** discloses a print according to claim 1 wherein the substrate is provided with an associated memory tag (Col. 4, lines 41-67).

Regarding **claim 7**, **Spurr** discloses a print according to claim 6 wherein each memory tag is located in the same place in the respective image area (Col. 5, lines 3-9 – *wherein the tag is located along an edge for each print, and it is disclosed that the tag may be situated in any suitable position as needed by the application*).

Regarding **claim 8**, **Spurr** discloses a print according to claim 6 wherein each memory tag is located in the same place with respect to the respective image (Col. 5, lines 3-9 – *wherein the tag is located along an edge for each print, and it is disclosed that the tag may be situated in any suitable position as needed by the application*).

Regarding **claim 9**, **Spurr** discloses a print according to claim 1 wherein it includes a further memory tag for storage of data relating to all of the images on the print (Col. 3, lines 40-44 & Col. 9, lines 18-22).

Regarding **claim 10**, **Spurr** discloses a print according to claim 1 wherein it includes an icon at the location for each memory tag (Col. 6, lines 23-27, 50-57 & Col. 9, lines 1-4 – *wherein it is disclosed that the tag may be coupled to the substrate via an operator using the trace pattern of the antenna as a guide, hence a visible "icon"*).

Regarding **claim 11**, **Spurr** discloses a print according to claim 1, wherein each memory tag is adapted to be inductively powered to transmit data stored thereon (Col. 5, lines 34-36 & Col. 6, lines 12-16).

Regarding **claim 12**, **Spurr** discloses a print medium with associated data storage, the print medium including a substrate with a printable surface (Col. 4, lines 41-61) and a plurality of memory tags coupled thereto at locations spaced apart over the area of the substrate (Col. 5, lines 5-9 & Col. 9, lines 18-22 - *wherein the tags can be placed at any suitable position and more than one tag can be used*), wherein each memory tag comprises a passive electronic memory (Col. 4, lines 64-66 & Col. 5, lines 34-36).

Regarding **claim 13**, **Spurr** discloses a print medium as claimed in claim 12, wherein each memory tag is adapted to be inductively powered for receiving data to be written to it (Col. 5, lines 34-36, 47-50 & Col. 6, lines 12-16).

Regarding **claim 14**, **Spurr** discloses a print medium according to claim 12 wherein a memory tag is located in each image area (Col. 3, lines 40-44 & 57-58).

Regarding **claim 15**, **Spurr** discloses a print medium according to claim 14 wherein each memory tag is located in the same place with respect to the image area in which it is located (Col. 5, lines 3-9 – *wherein the tag is located along an edge for each print, and it is disclosed that the tag may be situated in any suitable position as needed by the application*).

Regarding **claim 16**, **Spurr** discloses a print medium according to claim 14 wherein the memory tags are located in different locations within the image areas (Col. 5, lines 3-9 – *wherein the tag is located along an edge for each print, and it is disclosed that the tag may be situated in any suitable position as needed by the application*).

Regarding **claim 17**, **Spurr** discloses a method of storing data concerning a plurality of images, on a print medium (Col. 4, lines 41-61) including a substrate and a plurality of memory tags coupled thereto at locations spaced apart over the area of the substrate (Col. 5, lines 5-9 & Col. 9, lines 18-22 - *wherein the tags can be placed at any suitable position and more than one tag can be used*), each memory tag comprising a passive electronic memory (Col. 4, lines 64-66 & Col. 5, lines 34-36), the method comprising the steps of:

each image is adjacent to a memory tag (Col. 4, lines 62-67 & Fig. 1);

for at least some of the images storing data associated with the respective image in the memory tag adjacent to it (Col. 3, lines 53-54).

Regarding **claim 18**, **Spurr** discloses a method of storing data concerning a plurality of images comprising the steps of:

applying a memory tag (Col. 4, line 64 - Col. 5, line 2 & Col. 6, lines 40-48), comprising a passive electronic memory (Col. 4, lines 64-66 & Col. 5, lines 34-36), to the substrate adjacent to at least some of the images (Col. 4, lines 62-67 & Fig. 1), and;

for each image adjacent to which a memory tag has been applied, storing data associated with the image in the memory tag adjacent to it (Col. 3, lines 53-54).

Regarding **claim 19**, **Spurr** discloses a method according to claim 18 wherein the memory tags are applied to the substrate before the data is stored on them (Col. 6, lines 40-48 & Col. 9, lines 1-6).

Regarding **claim 20**, **Spurr** discloses a method according to claim 18 wherein the data is stored in the memory tags before they are applied to the substrate (Col. 6, lines 40-48 & Col. 9, lines 1-6).

**Spurr** fails to explicitly teach or particularly point out, wherein the print is an index print including a plurality of images, as recited in **claim 1**; the memory is adapted such that said data relating to the image includes the image in high resolution, as recited in **claim 1**; a print according to claim 1 wherein for each image in respect of which data is stored on an associated memory tag, the image is printed with low resolution, as recited in **claim 2**;

a print according to claim 1 wherein the substrate is divided into a plurality of image areas each of which has printed thereon a single image, as recited in **claim 6**;

the memory is adapted to store an image at high resolution, as recited in **claim 12**;

a print medium according to claim 12 wherein the substrate is divided into a plurality of image areas, as recited in **claim 14**;

a print medium according to claim 14 wherein the image areas form a regular grid, as recited in **claim 15**;

a print medium according to claim 14 wherein the image areas form a regular grid, as recited in **claim 16**;

said data including the respective image at high resolution, as recited in **claim 17**;

printing a plurality of visible images onto a substrate, as recited in **claim 17**;

said data including the respective image at high resolution, as recited in **claim 18**; and

printing a plurality of visible images onto a substrate, as recited in **claim 18**.

**Patton** teaches, regarding **claim 1**, wherein the print is an index print including a plurality of images (Col. 3, lines 4-16);

regarding **claim 2**, a print according to claim 1 wherein for each image in respect of which data is stored on an associated memory tag, the image is printed with low resolution (Col. 3, lines 4-16);

regarding **claims 6 & 14**, a print according to claim 1 & 12, respectively, wherein the substrate is divided into a plurality of image areas each of which has printed thereon a single image (Col. 3, lines 4-16);



regarding **claims 15 & 16**, a print medium according to claim 14 wherein the image areas form a regular grid (Col. 3, lines 4-16 & Fig. 1); and  
regarding **claims 17 & 18**, printing a plurality of visible images onto a substrate (Col. 3, lines 4-16) for the benefit of ease of viewing for the user rather than viewing negatives whereby a user can ascertain what pictures are present in a set of photos rather than going through each one individually and also for enhanced efficiency for the developer or merchant by allowing for a more convenient way for a user to select and order reprints.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further employ, within **Spurr**, the features of **Patton** for the benefit of ease of viewing for the user rather than viewing negatives whereby a user can ascertain what pictures are present in a set of photos rather than going through each one individually and also for enhanced efficiency for the developer or merchant by allowing for a more convenient way for a user to select and order reprints.

**Patton** teaches, regarding **claims 1, 17 & 18** the memory is adapted such that said data relating to the image includes the image in high resolution (Col. 2, line 55 – Col. 3, line 2 - *wherein it is disclosed that "image files" are stored corresponding to the imaggettes of the index print that contain information that can create viewable representation of the image and that "image files" of varying information density may be stored to recreate the image; therefore a high resolution image*); and

regarding **claim 12**, the memory is adapted to store an image at high resolution (Col. 2, line 55 – Col. 3, line 2 - *wherein it is disclosed that "image files" are stored corresponding to the imagerettes of the index print that contain information that can create viewable representation of the image and that "image files" of varying information density may be stored to recreate the image; therefore a high resolution image*) for the benefit of enhanced efficiency for the merchant and security for the user's photos by providing a safe and convenient way for a user to select and order reprints with the ability to access the image file right from the index print without having to involve negatives that could potentially be damaged or degraded in quality.

It would have been obvious to one of ordinary skill in the art at the time the invention was made to further employ, within **Spurr**, the features of **Patton** for the benefit of enhanced efficiency for the merchant and security for the user's photos by providing a safe and convenient way for a user to select and order reprints with the ability to access the image file right from the index print without having to involve negatives that could potentially be damaged or degraded in quality.

### ***Conclusion***

No claims are allowed.

The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Lane et al. (US 2004/0100363 A1).

Application/Control Number:  
10/565,368  
Art Unit: 2876

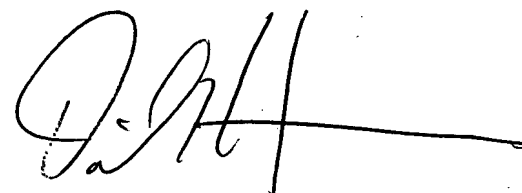
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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Paultep Savusdiphol whose telephone number is (571) 270-1301. The examiner can normally be reached on 9:00 - 4:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Michael G. Lee can be reached on (571) 272-2398. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

PS  
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